



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,150	01/23/2002	Ed Gancarcik	481340010041	5763

7590 09/22/2005  
David B. Cochran, Esq.  
JONES, DAY, REAVIS & POGUE  
North Point  
901 Lakeside Avenue  
Cleveland, OH 44114

EXAMINER
----------

GARY, ERIKA A

ART UNIT	PAPER NUMBER
----------	--------------

2681

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/055,150

Applicant(s)

GANCARCIK ET AL

Examiner

Erika A. Gary

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: on page 1, the foreign priority data should be included.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Pinard et al., US Patent Number 6,647,103 (hereinafter Pinard).

Regarding claim 1, Pinard discloses a personal digital assistant (PDA) enabled telephony system comprising: call control means for implementing telephony functions [fig. 4: refs PC3, 54], wherein said call control means comprises one of either a PBX or a call server [fig. 1: ref. 10]; a telephone set connected to said call control means and having a communication port [fig. 4: phone/docking station 1]; a PDA having a user interface for displaying telephony functions to a user, a detector for detecting a selected telephony function, a telephony application for determining a call command based on

Art Unit: 2681

said selected telephony function, and a communicator for communicating said call command to said communication port [fig. 4: PDA 5]; wherein said telephone set receives said call command and, in response, passes said selected call command to said call control means for implementing said selected telephony function [col. 1: line 62 – col. 2: line 6].

Regarding claim 2, Pinard discloses communication between said telephone set and said PDA is achieved via a protocol implemented via software within each of said telephone set and said PDA [col. 3: lines 50-56].

Regarding claims 3 and 4, it is inherent for protocols to comprise physical layers, an application or network interfaces, and encapsulation layers.

Regarding claim 5, Pinard discloses said telephone set includes communication means for enabling communication between said PDA and a call server [fig. 1].

Regarding claim 6, Pinard discloses said communication between said PDA and said call server is via one of either a TDM or IP based communication network [fig. 1; col. 4: lines 20-21].

Regarding claim 7, Pinard discloses said telephone set includes communication means for enabling communication between said PDA and a network node [fig. 1].

Regarding claims 8 and 13, Pinard discloses the physical layer comprises at least one of a wired interface or wireless interface [fig. 4: refs. 41, 42, 44, 46].

Regarding claim 9, Pinard discloses the wired interface comprises at least one of a serial interface, parallel interface, USB interface, tip and ring interface [fig. 4: refs. 41, 42].

Regarding claim 10, Pinard discloses the wireless interface comprises at least one of an infrared/IrDA interface, radio interface, and cellular interface [fig 4: refs. 44, 46].

4. Claims 1-10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Schuster et al., US Patent Number 6,584,490 (hereinafter Schuster).

Regarding claim 1, Schuster discloses a personal digital assistant (PDA) enabled telephony system comprising: call control means for implementing telephony functions, wherein said call control means comprises one of either a PBX or a call server; a telephone set connected to said call control means and having a communication port; a PDA having a user interface for displaying telephony functions to a user, a detector for detecting a selected telephony function, a telephony application for determining a call command based on said selected telephony function, and a communicator for communicating said call command to said communication port; wherein said telephone set receives said call command and, in response, passes said selected call command to said call control means for implementing said selected telephony function [fig. 1; col. 3: lines 32-34, 41-45; col. 7: lines 5-42; col. 8: lines 43-48].

Regarding claim 2, Schuster discloses communication between said telephone set and said PDA is achieved via a protocol implemented via software within each of said telephone set and said PDA [col. 4: lines 17-22].

Regarding claims 3 and 4, it is inherent for protocols to comprise physical layers, an application or network interfaces, and encapsulation layers.

Regarding claim 5, Schuster discloses said telephone set includes communication means for enabling communication between said PDA and a call server [col. 4: lines 17-22].

Regarding claim 6, Schuster discloses said communication between said PDA and said call server is via one of either a TDM or IP based communication network [col. 8: lines 10-25].

Regarding claim 7, Schuster discloses said telephone set includes communication means for enabling communication between said PDA and a network node [col. 8: lines 10-25].

Regarding claims 8 and 13, Schuster discloses the physical layer comprises at least one of a wired interface or wireless interface [col. 9: lines 54-56].

Regarding claim 9, Schuster discloses the wired interface comprises at least one of a serial interface, parallel interface, USB interface, tip and ring interface [col. 7: lines 31-40].

Regarding claim 10, Schuster discloses the wireless interface comprises at least one of an infrared/IrDA interface, radio interface, and cellular interface [col. 7: lines 31-40].

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris, US Patent Number 6,738,643 (hereinafter Harris).

Regarding claim 1, Harris teaches a personal digital assistant (PDA) enabled telephony system comprising: a call control means for implementing telephony functions [inherent]; a telephone set connected to a call control means and having a communication port [fig. 1: ref. 130]; a PDA having a user interface for displaying telephony functions to a user, a detector for detecting a selected telephony function, a telephony application for determining a call command based on said selected telephony function, and a communicator for communicating said call command to said communication port [fig. 1: ref. 100]; wherein said telephone set receives said call command and, in response, passes said selected call command to said call control means for implementing said selected telephony function [fig. 1; col. 1: lines 54-60; col. 2: lines 49-62]. Further regarding claim 1, the Examiner takes Official Notice that it is well known in the art for a call control means to comprise a PBX or a call server. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include a specific call control means as it is obvious that the telephone set is connected to some type of call control means. The specific call control means used lacks criticality to the overall function of the invention.

### ***Response to Arguments***

7. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Further the Examiner maintains that the declaration filed is insufficient because the Examiner does not see proof of printed dates indicating that the present invention was conceived prior to October 31, 2000.

Claims 1-10 and 13 are now also rejected under Schuster et al., which has a filing date of December 22, 1999.

#### Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 571-272-7841. The examiner can normally be reached on Monday-Thursday and alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 2681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EAG  
September 18, 2005

  
ERIKA A. GARY  
PRIMARY EXAMINER